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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fenmore International Ltd.

Serial No. 75/615,116

Lynn M. Jordan of Finnegan Henderson Farabow Garrett &
Dunner, LLP for Fenmore International Ltd.

James T. Griffin, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Cissel, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 4, 1999, Corporate Computer Systems Europe GmbH, a corporation organized and existing under the laws of Germany, filed the above-referenced application to register the mark "AAC" on the Principal Register for "electric, electronic and optical measuring, signaling, checking (supervision) apparatus and instruments included in Class 9, in particular electric devices and instruments for recording, transmission and reproduction of audio and

video signals; apparatus and instruments for recording, transmission and reproduction of audio signals and parts of such apparatus included in Class 9; transmission apparatus, receiving apparatus, apparatus for courtless (sic) transmission of acoustic signals, coders, decoders, computer programs stored on data carriers, software, data-processing devices and their parts included in Class 9."

As a basis for filing this application, applicant asserted that it possessed a bona fide intention to use the mark in commerce in connection with the listed goods. Applicant also claimed priority based on an application to register its mark which applicant had filed in Germany on July 1, 1998.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), based on his finding that confusion would be likely with two registered trademarks. He also refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark applicant seeks to register is merely descriptive of the goods listed in the application. In support of this refusal, he made of record a copy of a page from an on-line acronym dictionary which shows that "AAC" stands for "Advanced Audio Coding."

Additionally, the Examining Attorney held that the identification-of-goods clause in the application was indefinite. He made suggestions as to how applicant could amend this clause to satisfy the requirement for a definite identification of the goods.

Responsive to the first Office Action, applicant amended the application to identify its goods as follows: "reproduction instruments, recorders, editors, transmitters and receivers for audio and video signals and parts of the aforesaid goods; computer programs for controlling, tuning, editing, monitoring and reproduction signal transmissions, blank data cartridges, CD-ROMs, diskettes, disks and tapes, none of the aforementioned goods being telecommunications apparatus or access concentrators for similar goods." Applicant also argued that its mark is not merely descriptive and presented arguments that confusion would not be likely with the two cited registered marks. With regard to descriptiveness, applicant stated that the letters "AAC" are acronyms for a number of different things, "including such things as Air Armorment Center, Airborne Aircraft Controller, and American Adoption Congress."

The Examining Attorney suspended action on the application pending receipt of a certified copy of

applicant's German registration, but continued the refusals under Section 2(d) and 2(e)(1) of the Act, as well as the requirement for a more definite identification-of-goods clause. After applicant submitted the certified copy of its German registration and withdrew its intention to use the mark as a basis for the application under Section 1(b) of the Act, the Examining Attorney made final the requirement for a more definite identification-of-goods clause and also made final the refusals to register based on Sections 2(d) and 2(e)(1) of the Act.

Submitted with the final refusal to register were excerpts from articles retrieved from the Nexis automated database of publications which show the letters sought to be registered as an acronym for "advanced-audio-compression," which is a "format for CD quality sound at low and high bandwidths."

Following assignment of the application to the above-identified corporation and a change of attorneys, a timely Notice of Appeal was filed on August 16, 2001, along with a request for reconsideration, which included an amendment to the existing identification-of-goods clause. Applicant asked that it be replaced with the following: "equipment for processing, recording, reproducing, editing, storing, transmitting, and receiving audio signals; equipment and

computer software for processing, recording, reproducing, editing, storing, transmitting, and receiving audio data in a digital form; data cartridges, CD-ROMs, diskettes, computer disks, audio tapes, memory cards, and other medium (sic) capable of storing digital data in International Class 9."

Applicant argued in its request for reconsideration that based on the amended identification-of-goods clause, confusion would not be likely with either of the two cited registered marks, and further, that applicant's mark is not merely descriptive of the goods specified in the amended application.

Submitted in support of the request for reconsideration were copies of marketing materials which applicant contended establish that its mark is not merely descriptive and not likely to cause confusion with the two cited registered marks. Significantly, one of the printed brochures submitted by applicant identifies "AAC " as "The new global audio format," and states that "... as an MPEG-2 extension and as part of MPEG 4, AAC has proved itself capable of delivering audio of such outstanding quality that it is safe to assume it will become the next successful audio coding algorithm." The brochure announces that applicant "is proud to introduce the first MAYAH AAC

software to record and play AAC formatted files. AAC is very economical and can reduce transmission and storage costs by as much as 50%." The brochure goes on to state that applicant's recorder "[r]ecords and stores AAC coded formats."

The Trademark Trial and Appeal Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of applicant's request for reconsideration. Upon reconsideration, the Examining Attorney maintained the refusals under Sections 2(d) and 2(e)(1), as well as the requirement for a more definite identification of applicant's goods. Submitted with the Examining Attorney's response to applicant's request for reconsideration was a copy of an entry from the on-line Smart Computing dictionary, which explains that "Advanced Audio Coding (AAC)" is "[a] new competitor to the MP3 standard. AAC lets users download CD-quality recordings to their computers. The new standard promises better compression and, thus, faster download time span than the now widely used MP3 standard. AAC's developers claim the compression reduces the download time of a 3-minute song from 21 minutes to 9. There are several variations of AAC, however, and they aren't interchangeable... There are also

some players and encoders based on the public domain version of the AAC format available for free..."

The application file was returned to the Board, and action on the appeal was resumed. Applicant then timely filed its brief on appeal. In its brief, applicant submitted another amended version of the identification-of-goods clause. Applicant sought to amend its application to specify its goods as follows: "equipment for processing, recording, reproducing, editing, storing, transmitting, and receiving the audio signals, namely personal computers, optical disk players and recorders, magnetic disk players and recorders, magnetic tape players and recorders, hard-drive memories, alarm clocks, radios, analog and digital portable tape players, analog and digital portable disk players, analog and digital portable memory players, electrical wires and cables; software to enhance the capabilities of multimedia applications, namely applications to enhance the performance of any multimedia system; written data cartridges, CD-ROMs, diskettes, computer disks, RAM memories, semiconductor memories, and memory cards[,] all featuring entertainment in Class 9."

The application, along with applicant's brief, was forwarded to the Examining Attorney for his brief in accordance with Trademark Rule 2.142(b). Based on the

amended version of the identification-of-goods clause presented in applicant's appeal brief, the Examining Attorney withdrew the refusal to register based on likelihood of confusion. He maintained, however, that the refusal based on descriptiveness and the requirement for a more definite identification-of-goods clause are both well taken. He pointed out that the most recent amendment not only includes indefinite terminology, but also adds products which are not within the scope of the identification in the original application as it was filed.

Applicant timely filed a reply brief. In it, applicant attempted yet another amendment to the identification-of-goods clause in the application. This time, applicant sought to remove the goods which the Examining Attorney found to be outside the scope of the original application, and applicant sought to clarify some of the other products listed in the amendment applicant had submitted with applicant's appeal brief.

Applicant did not request an oral hearing before the Board.

At the outset, we need to clarify which of the various identification-of-goods clauses proffered by applicant is being considered in this appeal. Trademark Rule 2.64(a) provides that an applicant's response to a refusal of

registration or a requirement that has been either repeated or designated as final is limited either to compliance with the requirement or to an appeal. Ordinarily, unless the Examining Attorney agrees to it or applicant had been granted permission by the Board to amend the application after the appeal had been filed, any such amendments would not be considered. The proper procedure for the Examining Attorney to have followed when he was presented with the amendment applicant included with its appeal brief was to return the application file to the Board to act on applicant's request to amend. This was not done, however. The Examining Attorney apparently took the position that he should consider the amendment applicant had proffered in its brief, and when he did this, as noted above, he found that although the amended identification-of-goods clause still fell short of being sufficiently definite, it nonetheless provided him with a basis upon which to withdraw the refusal to register based on Section 2(d) of the Act.

Because the Examining Attorney treated this amendment as if it had been properly made, and in view of the fact that it eliminated one of the grounds for refusing registration, we have considered the amendment as if it had been timely made in accordance with the Trademark Rules of

Practice. The subsequent amendment offered by applicant in its reply brief, however, has not been considered. The Examining Attorney did not consider this amendment.

Accordingly, for purposes of this appeal, the identification-of-goods clause referred to in applicant's appeal brief is the version we have considered. We agree with the Examining Attorney that this amendment fails for two reasons. First, it includes "alarm clocks" and "electric wires and cables," which are all goods outside of the scope of the goods listed in the application as it was originally filed. Trademark Rule 2.71(a) permits amendments "to clarify or limit, but not to broaden," the identification of goods. Second, this version of the identification-of-goods clause refers to "written data cartridges, CD-ROMs, diskettes, computer disks, RAM memories, semiconductor memories, and memory cards[,] all featuring entertainment," but this terminology does not indicate what type of entertainment is stored on these products, and without an indication of the subject matter, this language does not provide enough information about the goods to allow accurate determinations of whether confusion is likely with other marks. The wording proposed by applicant is simply not specific enough.

The requirement for an amended identification-of-goods clause which includes only goods encompassed within the application as it was originally filed, and which does not include indefinite terminology, is accordingly affirmed.

We therefore turn to the second issue before us in this appeal, i.e., whether the mark applicant seeks to register is merely descriptive of the goods specified in the application, as amended. The test for registrability under Section 2(e)(1) of the Lanham Act is well settled. A mark is merely descriptive, and hence unregistrable, if it immediately and forthwith describes a significant ingredient, quality, characteristic, function, feature, purpose or use of the goods in connection with which the mark is, or is intended to be, used. In *re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In *re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); In *re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Applicant "concedes," (brief, p. 5), that the letters it seeks to register "can be used as an abbreviation for 'advanced audio coding.'" In any event, the evidence submitted by the Examining Attorney makes this clear. Further, this record establishes that Advanced Audio Coding, or "AAC," is a format for downloading digital music. As noted above, applicant itself uses this acronym

descriptively, and indicates in its own promotional material that the acronym "AAC" stands for "Advanced Audio Coding," ... "the new global audio format." In that the goods listed in the amended identification-of-goods clause process, record, reproduce, edit, transmit and receive audio signals, the letters "AAC" describe a key feature or characteristic of applicant's products, namely that they can play and/or record AAC files.

Applicant's arguments to the contrary are not persuasive. Applicant notes that the evidence of record indicates that there are nineteen definitions for this initialism (including, e.g., "Aerial Ambulance Co."), and argues that the purchasing public would not necessarily associate "Advanced Audio Coding" with its goods. As the Examining Attorney points out, however, it is well settled that the descriptiveness of a term must be determined not in the abstract, but rather in relation to the goods identified in the application and the possible significance that the term is likely to have to purchasers of these products because of the manner in which it is used in connection with them. In re Abcor Development Corp., 588 F.2d 811,200 USPQ 215 (CCPA 1978). That a term may have other meanings in different contexts is not controlling on the question of descriptiveness. In re Bright-Crest, Ltd.,

supra. In the instant case, the goods are recording and playback devices and multimedia software which utilize AAC technology. In connection with these products, purchasers would clearly associate "Advanced Audio Coding" with the letters "AAC." Because this technology is a significant feature or characteristic of these products, "AAC" is merely descriptive of them within the meaning of Section 2(e)(1) of the Lanham Act.

DECISION: The requirement for a definite identification-of-goods clause which does not include products outside the scope of the application as it was filed is affirmed. The refusal to register under Section 2(e)(1) of the Lanham Act because the mark is merely descriptive of the goods set forth in the amended application is also affirmed.